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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/738,411

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Derrick B. McKie

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AVON PRODUCTS, INC.

AVON PLACE

SUFFERN, NY 10901

EXAMINER

WANG, SHENGJUN

ART UNIT

PAPER NUMBER

1617

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/738,411	Applicant(s) MCKIE ET AL.	
	Examiner Shengjun Wang	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 22 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 23-25 and 27-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted August 22, 2007 is acknowledged.

Claim Rejections 35 U.S.C. 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 23-25, 27-34, are rejected under 35 U.S.C. 103(a) as being unpatentable over Beerse et al. (US 6,294,186, IDS), in view of Duennenberger et al. (US 3,708,527, IDS), Perricone (US 6,743,433), and Wiegand et al. (US 2002/0151527, IDS).

Beerse et al. teaches a method of treating or preventing dandruff and acne comprising applying a topical composition comprising a benzoic acid derivatives, wherein the benzoic acid have hydroxyl, or halogen substituents at 2-6 positions, halogenated salicylic acids, such as 5-chlorosalicylic acid, 5-bromosalicylic acid, 5-fluorosalicylic acid, etc, are listed as preferred compounds. The amount of the benzoic acid derivative in the composition is in the range of 0.01-20%. See, particularly, the abstract; col. 3, lines 54-62; col. 6, lines 5-19; and the claims. Beerse et al. further teaches that dimethicone may be incorporated into the topical composition. See, particularly, col. 10, lines 39-48. Other active and well known cosmetics agents may also incorporated into the topical compositions includes antioxidants, such as ascorbic acid (vitamin C) or its derivatives, thiols, such as ethane thiol, and lipoic acid. See, cols. 19-30, particularly, col. 28, lines 50-60; col. 30, lines 25-40.

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Beerse et al. do not teach expressly the employment of the halogenated salicylic acids for treating the skin conditions associated with the acne.

However, Duennenberger et al. teaches that the salt of 5-chlorosalicylic acid is known to be an antimicrobial agents and useful in cosmetic composition. Wiegand et al. disclosed that sebum output, and bacterial infection is closely related to acne. Further, acne vulgaris would greatly affect skin appearance. See, particularly paragraphs 0007-0010. Perricone reveals that acne is associated with skin pore size and treatment of acne is also beneficial in reducing pore size. See, col. 3, lines 15-25.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the claimed invention was made, to employ the particular halogenated salicylic acids disclosed by Beerse et al. for treating subject with acne and/or dandruff.

A person of ordinary skill in the art would have been motivated to employ the particular halogenated salicylic acids disclosed by Beerse et al. for treating subject with acne and/or dandruff because the halogenated salicylic acid is known to be useful for treatment of acne. Furthermore, one of ordinary skill in the art would have expected the halogenated salicylic acid be useful against acne as an antimicrobial agent.

Furthermore, the optimization of a result effective parameter, e.g. the effective amounts of the active ingredients in a therapeutical method, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. Finally, incorporation of other ingredients known to be useful in the composition, such as vitamin C, lipoic acid, dimethicone, would have been within the purview of ordinary skill in the art.

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Claims 8, 9, 32 and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beerse et al. (US 6,294,186, IDS), in view of Duennenberger et al. (US 3,708,527, IDS), Perricone (US 6,743,433), and Wiegand et al. (US 2002/0151527, IDS), for reasons discussed above, and in further view of O'Halloran et al. (US 6,168,798).

The prima references as a whole, do not teach expressly the employment of salicylic acid, and/or lactic acid for the treatment of acne and associated conditions.

However, O'Halloran et al. teach that β -hydroxyl-carboxylic acids, particularly, salicylic acid, and α -hydroxyl-carboxylic acid, such as lactic acid and glycolic acid, are useful for treating acne and skin conditions associated with acne. The effective amount of salicylic acid is about 0.1% to about 15% by weight of the total composition. See, particularly, the abstract, col. 2, lines 22-30, col. 4, line 56 to col. 5, lines 27, and the claims.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to further employ salicylic acid and/or lactic acid. with the halogenated salicylic acid for treatment of acne and associated skin conditions.

A person of ordinary skill in the art would have been motivated to further to further employ salicylic acid with the halogenated salicylic acid for treatment of acne and associated skin conditions because it is prima facie obvious to combine two compositions each of which is taught in the prior art to be useful for same purpose in order to form third composition that is to be used for very the same purpose; idea of combining them flows logically from their having been individually taught in prior art. See In re Kerkhoven, 205 USPQ 1069.

Claims 10-21 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beerse et al. (US 6,294,186, IDS), in view of Duennenberger et al. (US 3,708,527, IDS),

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Perricone (US 6,743,433), and Wiegand et al. (US 2002/0151527, IDS), for reasons discussed above, and in further view of Gormley et al. (US 6,174,892), Menon et al. (WO 01/66080).

The prima references as a whole, do not expressly teach the employment of phytol, finasteride, and/or retinol for the treatment of acne and associated conditions.

However, Gormley et al. teach that 5 α -reductase inhibitors, such as finasteride, are useful for treatment of acne. See, particularly, the abstract, and the claims. Monen et al. teaches that phytol is useful for treatment of a variety of skin conditions, including acne and associated condition. See, particularly, page 2, line 20 to page 3, line 15. Phytol is particularly useful with other well-known skin caring agents, such as retinoid, salicylic acid, 5-alpha-reductase inhibitor, such as saw palmetto and finasteride. See, particularly, pages 7-9.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to further employ 5 α -reductase inhibitors, such as finasteride, phytol, and/or retinol, with the halogenated salicylic acid for treatment of acne and associated skin conditions.

A person of ordinary skill in the art would have been motivated, to further employ 5 α -reductase inhibitors, such as finasteride, phytol, and/or retinol, with the halogenated salicylic acid for treatment of acne and associated skin conditions because it is prima facie obvious to combine two compositions each of which is taught in the prior art to be useful for same purpose in order to form third composition that is to be used for very the same purpose; idea of combining them flows logically from their having been individually taught in prior art. See In re Kerkhoven, 205 USPQ 1069. Note the Anti-ageing active ingredients recited in claim 20 are

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defined to include anti-wrinkle agent, such as retinoid. See, page 1, lines 22-23, page 13, lines 10-20 of the specification.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beerse et al. (US 6,294,186, IDS), in view of Duennenberger et al. (US 3,708,527, IDS), Perricone (US 6,743,433), and Wiegand et al. (US 2002/0151527, IDS), for reasons discussed above, and in further view of Ptchelintsev et al. (US 5,834,513).

The prima references as a whole, do not expressly teach the employment of trioxaundecanedioic acid for the treatment of acne and associated conditions.

However, Ptchelintsev et al. teaches that oxa diacids, trioxaundecanedioic acid in particular, are known to be useful for treatment of a variety of skin conditions, including acne, blemished skin, hyperkeratosis. See, particularly, col. 2, line 54 to col. 3, line 3, and the claims.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to further employ oxa diacids, such as trioxaundecanedioic acid, for treatment of acne and associated skin conditions.

A person of ordinary skill in the art would have been motivated, to further employ oxa diacids, such as trioxaundecanedioic acid, for treatment of acne associated skin conditions because it is prima facie obvious to combine two compositions each of which is taught in the prior art to be useful for same purpose in order to form third composition that is to be used for very the same purpose; idea of combining them flows logically from their having been individually taught in prior art. See In re Kerkhoven, 205 USPQ 1069.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beerse et al. (US 6,294,186, IDS), in view of Duennenberger et al. (US 3,708,527, IDS), Perricone (US

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6,743,433), and Wiegand et al. (US 2002/0151527, IDS), in further view of O'Halloran et al. (US 6,168,798) for reasons discussed above, and in further view of Duffy (US 5,703,122)

The prima references as a whole, do not expressly teach the employment of ascorbyl-phosphoryl-cholesterol in the composition for the treatment of acne and associated conditions.

However, Duffy teaches that ascorbyl-phosphoryl-cholesterol is known to be useful in dermatological composition which contains a-hydroxyl acid, salicylic acid and/or retinoids. See, particularly, claim 1.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to further employ ascorbyl-phosphoryl-cholesterol in the composition for treatment of acne associated skin conditions.

A person of ordinary skill in the art would have been motivated, to further employ ascorbyl-phosphoryl-cholesterol in the composition for treatment of acne associated skin conditions because ascorbyl-phosphoryl-cholesterol is known to reduce the side effect of the active ingredients herein. Further, as ascorbic acid derivatives, ascorbyl-phosphoryl-cholesterol would have been reasonably expected to be similarly useful as ascorbic acid.

Response to the Arguments

Applicants' amendments and remarks submitted August 22, 2007 have been fully considered, but are not persuasive.

Applicants contend that claims as amended are particularly directed to a method of reducing the size of enlarged skin pores and would have not been obvious over the cited prior art, which mainly drawn to treatment of acne. The arguments are found unpersuasive. As stated in

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the prior office action, in view of the state of the art revealed in the cited references the species of skin conditions are related and indistinct each from the other. Particularly, all the conditions are associated with acne.

2. In response to applicant's argument that the cited prior art do not teach expressly the reduction or skin pore size, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Particularly, the cited reference as a whole, teaches that salicylic acid and halogen substituted derivatives are known to be useful for treating acne, and the particular skin condition herein is associated with acne, or one of the symptoms of acne.

The instant claims are directed to effecting a biological function, reducing skin pore size, with an old and well known method, i.e., treating acne with halogen substituted salicylic acid. The argument that such claims are not directed to the old and well known ultimate utility (treatment of acne) for the compounds, e.g., substituted salicylic acid, are not probative. It is well settled patent law that mode of action elucidation does not impart patentable moment to otherwise old and obvious subject matter. Applicant's attention is directed to *In re Swinehart*, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated "is elementary

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that the mere recitation of a newly discovered function or property, inherently possessed by thing in the prior art, does not cause a claim drawn to those things to distinguish over the prior art.” In the instant invention, the claims are directed to the ultimate utility set forth in the prior art, albeit distanced by various biological function. The ultimate utility for the claimed compounds is old and well known rendering the claimed subject matter obvious to the skilled artisan. It would follow therefore that the instant claims are properly rejected under 35 USC 103.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shengjun Wang **SHENGJUN WANG**
Primary Examiner **PRIMARY EXAMINER**
Art Unit 1617

